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Guy E. Beardsley

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	David Moore et al.	Art Unit:	1646
Serial No.:	09/365,576	Examiner:	M. Pak
Filed:	August 2, 1999	Customer No.:	21559
Title:	RETINOID X RECEPTOR-INTERACTING POLYPEPTIDES AND RELATED MOLECULES AND METHODS		

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION TO REQUEST WITHDRAWAL OF
FINALITY UNDER 37 C.F.R. § 1.181

Appellants hereby request, under 37 C.F.R. § 1.181, that the final rejection of claims 7, 10, 13-16, and 27-31 as applied in the Advisory Action mailed June 30, 2003 be withdrawn.

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Background

On June 28, 2001, claims 7, 10, 13-16, and 27 were rejected under 35 U.S.C. § 102(e) as being anticipated by Liao *et al.* (U.S. Pat. No. 5,639,616). In connection with this rejection, the Office stated:

Liao *et al.* disclose ubiquitous nuclear receptor which is 97.1% identical to SEQ ID NO: 3. Claims 7 and 10 encompass human RAR because the recitation of "substantially identical" is defined in the specification (page 6, lines 27-34) to encompass unlimited number of non-conservative substitutions, deletions, and insertions and as defined RAR is substantially identical to SEQ ID NO 3. The ubiquitous receptor has the identical amino acid sequence as the DNA binding region of SEQ ID NO: 5 and thus inherently binds the DNA response element of RARE and ECRE.

On December 21, 2001, appellants replied to this rejection as follows:

Claims 7, 10, 13-16, and 27 stand further rejected under 35 U.S.C. § 102(e) as being anticipated by Liao *et al.* (U.S.P.N. 5,639,616). As stated in the attached Declaration of inventor Dr. David Moore, the RIP15 clone was isolated and sequenced prior to the November 10, 1993 filing date of Liao. Because the claimed invention was reduced to practice prior to the filing of Liao, Liao cannot constitute prior art to the present claims under 35 U.S.C. § 102(e). Accordingly, this rejection should also be withdrawn.

Appellants further noted:

For the record, applicants note that a PCT application (WO 95/13373, filed November 4, 1994) corresponding to the Liao U.S. patent has claims that recite nuclear receptor polypeptides (claims 17-22). While applicants are not aware of a related, pending U.S. patent application or issued U.S. patent that claims nuclear receptor polypeptides, applicants note that there is a possibility that a pending U.S. application claims overlapping subject matter with the present case.

In the Office's final action, claims 7, 10, 13-14, 16, 27, 28, and 31 were again rejected under 35 U.S.C. § 102(e) as being anticipated by Liao *et al.* (US 5,639,616). The Office stated:

Liao *et al.* disclose ubiquitous nuclear receptor which is 97.1% identical to SEQ ID NO: 3 and thus meets the claim limitations directed percent identity of claims 7, 10, 13, 15-16, 27, 28, and 31.

The ubiquitous receptor has the identical amino acid sequence as the DNA binding region of SEQ ID NO: 5 and thus inherently binds the DNA response element of RARE and ECRE. The ubiquitous receptor inherently binds the RXR. Liao *et al.* teach the human receptor of ubiquitous receptor (column 12) which meets the claim 14 limitation drawn to derived from human.

On October 23, 2002, appellants replied to the final rejection of these claims as follows:

Claims 7, 10, 13-14, 16, 27, 28, and 31 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Liao *et al.* (U.S.P.N. 5,639,616). The Declaration of inventor Dr. David Moore, filed December 28, 2001, presented documentation of exemplary RIP15 cDNA sequence obtained prior to the November 10, 1993 filing date of Liao. The attached Declaration of Dr. Moore presents additional documentation of the sequencing of RIP15 prior to the filing of date of Liao. In particular, Exhibit 1 contains the entire amino acid sequence of RIP15, which was predicted based on the sequence of the full-length RIP15 cDNA. Thus, RIP15 was characterized by its ability to interact with RXR and by its complete amino acid sequence prior to November 10, 1993. Because the claimed invention was reduced to practice prior to the filing of Liao, Liao cannot constitute prior art to the present claims under 35 U.S.C. § 102(e). Accordingly, this rejection should also be withdrawn.

In addition, appellants, in their appeal brief filed March 24, 2003, addressed the § 102(e) rejection as follows:

The Declaration of inventor Dr. David Moore, filed December 28, 2001, presented documentation that Appellants obtained an exemplary RIP15 cDNA sequence prior to November 10, 1993... Because the claimed invention was reduced to practice prior to the earliest filing date of Liao, Liao cannot constitute prior art to the present claims under U.S.C. § 102(e).

On June 30, 2003, the Office, in its Advisory Action, maintained the § 102(e) rejection as follows:

In regard to the 102(e) rejection as being anticipated by Liao *et al.*, the Declaration of Dr. Moore filed December 28, 2001 does not overcome the rejection because applicant did not provide [a] showing under 37 C.F.R. 1.608(b). See MPEP 2308.02.

The § 102(e) Rejection, as Applied in the June 30, 2003 Advisory Action, Constitutes a New Ground of Rejection

As is clear from the above-stated facts, the Office, in both its first and final actions, had rejected the claims, under § 102(e), on the grounds that “Liao et al. disclose ubiquitous nuclear receptor which is 97.1% identical to SEQ ID NO:3.” The Office’s requirement for a showing under 37 C.F.R. 1.608(b) was first raised in its Advisory Action mailed June 30, 2003. To properly raise this issue, the finality of the rejection must be withdrawn in order to apply the new ground of rejection concerning the showing under 37 C.F.R. 1.608(b).

CONCLUSION

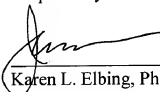
Because the Office has applied a new ground of rejection in this case, Appellants submit that the finality of the Office action issued April 23, 2002 be withdrawn.

Enclosed is a check in the amount of \$130.00 in payment of the fee required by 37 C.F.R. § 1.17(h).

If there are any other charges, or any credits, with respect to this petition, please apply them to Deposit Account No. 03-2095.

Respectfully submitted,

Date: 2 September 2003



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